

REMARKS

Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

The Examiner's communication of July 12, 2007, together with the references cited therein, have been given careful consideration. After such consideration, and in an earnest effort to complete the prosecution of this application, the Applicants have set down the following arguments in support of the patentability of claims 1-20.

To assist the Examiner in reconsidering this application, the following is a presentation based on the language employed in claims 1, 11, and 15 when read on the embodiment presented in Figs. 1-3. Claim 1 recites a system for enabling a hand-held, mobile data acquisition device. The system comprises a software application for use with the mobile data acquisition device. The software application is located on a remote computer. The remote computer transfers the software application from the remote computer to the

mobile data acquisition device. The remote computer installs and activates the software application for use by the mobile data acquisition device. The software application is determined by a user and replaces a factory default software application.

Claim 11 recites a system for enabling a software application. The system comprises a hand-held, mobile data acquisition device for use with the software application and a remote computer for transmitting the software application from the remote computer to the mobile data acquisition device. The remote computer installs and activates the software application for use by the mobile data acquisition device. The mobile data acquisition device has the capability of disabling a software application of the mobile data acquisition device.

Claim 15 recites a computer program product for enabling a software application. The computer program product is stored in a tangible medium. The computer program product comprises: a first instruction for initiating communication

between a hand-held, mobile device and a remote computer; a second instruction for requesting the state of the mobile device by the remote computer; a third instruction for responding to the remote computer by the mobile device with a factory default state message; a fourth instruction for initiating transfer of a software application from the remote computer to the mobile device; and a fifth instruction for acknowledging receipt of the software application from the remote computer by the mobile device thereby enabling the software application at the mobile device.

In section 4, titled "Note", the Office Action requires that the word "for" in the preamble of claims 1, 11, and 15 be changed to a positive recitation of the remaining language of the preamble (Office Action, page 2, paragraph 4). Applicant's representative repeats that he is unaware of any law or rule enacted by the courts or the MPEP that support this requirement.

The following is our understanding of the law regarding this issue. Functional language does not, in and of itself,

render a claim improper. MPEP §2173.05(g). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. MPEP §2173.05(g).

Additionally, all words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 165 USPQ 494, 496 (CCPA 1970). The elements of a prior art reference must be arranged in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 9 USPQ.2d 1913, 1920 (Fed. Cir. 1990). The proper inquiry is whether a claim is patentably distinguishable over the disclosure of the prior art. See In re Garnero, 162 USPQ 221, 223 (CCPA 1969); Water Tech. Corp. v. Calco Ltd., 7 USPQ.2d 1097, 1102 (Fed. Cir. 1988).

Further, a claim preamble has the import that the claim as a whole suggests for it. MPEP §2111.02. If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, then the claim preamble

should be construed as if in the balance of the claim. MPEP §2111.02. Thus, since the claim limitations "mobile data acquisition device" in claim 1 and "software application" in claims 11 and 15 are recited in the body of claims 1, 11, and 15 at least three further times, the preamble of claims 1, 11, and 15 "should be construed as if in the balance of the claim" and should not be ignored as the Office Action has apparently done. **Again, Applicant's representative respectfully requests that the source and basis of this requirement be cited in a non-final rejection of a subsequent Office Action.**

Claims 1-8, 11, and 13-20 have been rejected as unpatentable over by Delo et al., US 6,370,686. Claims 9, 10, and 12 have been rejected as unpatentable over Delo et al. in view of Larsson et al., US 6,226,747.

Claims 1, 11, and 15 each recite transferring a software application to a hand-held, mobile device. As stated in the Office Action, Delo et al. do not disclose transferring a software application to a hand-held, mobile device (Office

Action, page 4). The art of record does not even disclose transferring a software application to a mobile device.

Thus, it appears that the position of the Office Action is that it would have been obvious to replace the target computer (20) of Delo et al. with a hand-held, mobile device, as recited in claims 1, 11, and 15. The Office Action concludes that, since updating of hand-held, mobile devices is well-known, it would have been obvious to apply the method of Delo et al. to a hand-held, mobile device.

First, this conclusion ignores the added complexity created by updating a hand-held, mobile device versus a stationary device. This complexity may be created by possible interference incurred by a moving device, the intermittent nature of such interference, etc. It is respectfully submitted that, because of these added hurdles present in an update of a hand-held, mobile device, it would not have been obvious to one of ordinary skill in the art to simply use the method of Delo et al. in such a manner. One of ordinary skill in the art would recognize that the method of Delo et al.

would be unsatisfactory for its intended purpose if applied to a hand-held, mobile device. See MPEP §2143.01.

Second, the M.P.E.P. sets forth the following criteria for an obviousness rejection under 35 U.S.C. §103:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, MPEP §706.02(j).

The structure of a system or product for carrying out an algorithm is limited by the disclosed algorithm. See WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1348 (Fed. Cir. 1999). A new machine (a special purpose computer) is created when a general purpose computer is programmed to carry out an algorithm for performing one or more particular functions. Id. citing In Re Alappat, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (*en banc*). When a general purpose computer is

programmed to perform a particular function by using a discovery not specified in the prior art, the resulting system or product would not be obvious under 35 U.S.C. §103 "because one not having knowledge of the [inventor's] discovery simply would not know what to program the computer to do." See In re Prater, 415 F.2d 1393, 1397-98 (CCPA 1969).

For an obviousness rejection under 35 U.S.C. §103, the prior art must be analyzed at the time the invention was made. The use of the teachings of the present invention to find obviousness is impermissible.

Obviousness must not be read into an invention on the basis of applicant's own statements; that is, the prior art must be viewed without reading into that art the applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention obvious. In Re Sponnoble, 160 USPQ 237, 243 (CCPA 1969) (emphasis in original).

Accordingly, the Examiner must consider only the teachings of the prior art references. As admitted in the Office Action, Delo et al. fails to teach or suggest the limitations of claims 1, 11, and 15 (Office Action, page 4). Therefore, it is clear that the features of claims 1, 11, and 15 are not taught by Delo et al. According to WMS Gaming Inc., 184 F.3d at 1348, the system or product of claims 1, 11, and 15 define the algorithm for transferring a software application to a hand-held, mobile device. Since Delo et al. admittedly fails to teach or suggest these limitations, Delo et al. fails to teach or suggest a system or product as recited in claims 1, 11, or 15. Since Delo et al. fails to teach or suggest each feature of the claimed invention, it is respectfully submitted that it would not have been obvious to one of ordinary skill in the art to modify Delo et al. as suggested by the Office Action.

Additionally, when an algorithm is not taught or suggested by a prior art reference, one of ordinary skill in the art would not know what to program a computer to do. See e.g., In re Prater, 415 F.2d at 1397-98. Thus, a new system

or product has been created when a computer is programmed to carry out an algorithm to perform a particular function, as in claims 1, 11, and 15. WMS Gaming Inc., 184 F.3d at 1348. Therefore, it is respectfully submitted that it would not have been obvious for one of ordinary skill in the art to apply the method of Delo et al. to a hand-held, mobile device to produce the limitations of claims 1, 11, and 15.

Furthermore, in rejecting claims 1, 11, and 15 as obvious over Delo et al., it is respectfully suggested that improper hindsight has been used. Delo et al. fails to teach or suggest transferring a software application to a hand-held, mobile device. Thus, without reference to the teachings of the disclosure of the present invention, one of ordinary skill in the art would not have the requisite knowledge to modify Delo et al. in this manner.

According to In Re Sponnoble, 160 USPQ at 243 (CCPA 1969), such hindsight is impermissible. Therefore, it is respectfully submitted that for this further reason, the rejection of claims 1, 11, and 15 are improper.

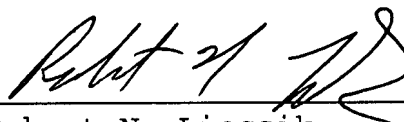
Consequently, claims 1, 11, and 15, as well as claims 2-10, 12-14, and 16-20 which depend from claims 1, 11, and 15, respectively, are in condition for allowance. Allowance of the subject application is respectfully requested.

Also, regarding claim 10, please note that the Office Action, page 12, states that Delo et al. does not disclose that the remote computer requests an application activation file from the mobile data acquisition device. However, the Office Action, page 7, states that Delo discloses that the remote computer requests an application activation file from the mobile data acquisition device, citing Col. 11, lines 61-67. Clarification of this inconsistency in a non-final rejection of a subsequent Office Action is respectfully requested.

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Please charge any deficiency or credit any overpayment in
the fees for this amendment to our Deposit Account No. 20-
0090.

Respectfully submitted,



Robert N. Lipcsik
Reg. No. 44,460

TAROLLI, SUNDHEIM, COVELL,
& TUMMINO, LLP
Phone: (216) 621-2234
Fax: (216) 621-4072
Customer No. 26294